

**Amendments to the Drawings**

Submitted herewith are new drawing Figures 1 and 2 that have been amended by replacing the reference number (20) with the reference number –22–.

## **REMARKS**

### **Claim Objections**

Claims 1 and 3 have been objected to for a misspelling of "elongate." These have been corrected by amendments to claims 1 and 3 presented herein.

Claims 1, 2, 3, 7, 8, and 14 have been objected to for reciting the phrase "a piston mounted on the rod adjacent the rod distal end for axially reciprocating movement of the piston," or other similar phrases. These phrases were considered to be unclear. These claims have been amended herein in the manner suggested by the Examiner. It is therefore believed that these amendments overcome the basis for these objections.

Claim 1 was objected to for reciting "a plurality of resilient arms that extend along the rod to distal ends of the arms." The phrase was considered to be confusing because it is obvious that the arms would extend to distal ends. However, the phrase positively recites the arms having distal ends to provide antecedent bases for several references to the arm distal ends later in claim 1. Therefore, the language is not confusing.

### **Specification**

The specification was objected to for the piston stop 22 in the specification being labeled with the reference number "20" in the drawings. Submitted herewith is an amendment of the drawing figures in which the reference number "20" is replaced by the reference number --22--. It is believed that this amendment of the drawings overcomes the objection to the specification.

The Abstract of the disclosure was objected to for not being provided on a separate sheet. However, in the application as filed the Abstract was on a separate sheet, i.e., page 16 of the application. It is therefore believed that the application is in compliance with MPEP § 608.01(b).

#### **Claim Rejections – 35 U.S.C. § 102**

Claims 1, 3-9, 12 and 13 were rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of the U.S. Patent of Richards No. 5,634,918. Of these rejected claims, claims 1 and 3 are independent claims, and claim 8 has been amended into independent form herein. It is respectfully submitted that the independent claims and their dependent claims that are the subject of the rejection recite elements of the invention that are not identically shown by the Richards reference, and therefore the Richards reference does not anticipate the subject matter of these claims under the patent law.

For a prior-art reference to anticipate, every element of the claimed invention must be identically shown in a single reference.

*In Re Bond*, 910 F.2d 831, 15 USPQ 2d 1566, 1567 (Fed. Cir. 1990).

[A]ny degree of physical difference, however slight, invalidates claims of anticipation.

*Ultradent Products, Inc. v. Life-Like Cosmetics, Inc.*, 924 F. Supp. 1101, 39 USPQ 2d 1969, 1980 (D. Utah 1996), *aff'd* in part, *rev'd* in part on other grounds, 127 F.3d 1065, 44 USPQ 2d 1336 (Fed. Cir. 1997).

Anticipation requires identity of invention. The claimed invention, as described in appropriately construed claims, must be the same as that of the reference in order to anticipate.

*Glaverbel Societe Anonyme v. Northlake Marketing & Supply, Inc.*, 45 F.3d 1550, 33 USPQ 2d 1496, 1498, 1995-1 Trade Cas. (CCH) P 70891 (Fed. Cir. 1995).

Unpatented claims are accorded the broadest reasonable interpretation consistent with the specification.

*Application of Barr*, 58 CCPA 1388, 444 F.2d 588, 170 USPQ 330, 335 (1971).

Independent Claim 1

Claim 1 recites a surgical instrument having an elongate rod 14 and a forward grip member 82 mounted on the rod. The claim further describes the forward grip member 82 as having a plurality of resilient arms 102 that extend along the rod 14 to distal ends 92 of the arms. In the rejection of claim 1 for being anticipated by the Richards reference, the rejection refers to Figure 5 of the Richards reference and interprets the rod 14' of Figure 5 as the rod of claim 1. The rejection interprets the trigger retainer 22' of Figure 5 as the forward grip member of claim 1. The rejection also interprets the pins 40' of Figure 5 as the resilient arms of claim 1. However, claim 1 recites "the forward grip member having a plurality of resilient arms that extend along the rod to distal ends of the arms." In viewing Figure 5, the pins 40' are separate component parts from the trigger retainer 22'. The trigger retainer 22', which is interpreted as the claimed forward grip member, does not have a plurality of resilient arms as required by claim 1. Therefore, Figure 5 of the Richards reference does not identically show every element of the invention recited in claim 1, as is required for a proper anticipation rejection under the above-cited case law. Interpreting the language of claim 1 consistent with the specification, as is required by the above-cited case law, the Richards reference does not identically show every element of the claimed invention. The Richards reference therefore does not anticipate claim 1, and claim 1 is allowable over the prior art.

### Independent Claim 3

Claim 3 recites subject matter of the invention similar to that of claim 1, but also has been amended herein changing "a plurality of resilient arms operatively connected with the forward grip member," to "a plurality of resilient arms integrally connected with the forward grip member." Referring to Figure 5 of the Richards reference, the pins 40' that are interpreted as the claimed resilient arms are separate component parts from the trigger retainer 22' which is interpreted as the forward grip member. The pins 40' are not integrally connected with the trigger retainer 22'. Therefore, the Richards reference does not identically show every element of the invention recited in amended claim 3, and does not anticipate claim 3. Claim 3 and its dependent claims 4-9, 12 and 13 are therefore allowable over the Richards reference.

### **Amended Independent Claim 8**

Dependent claim 8 has been amended into independent form herein by adding all of the subject matter of original independent claim 3 into new independent claim 8. In the rejection of original dependent claim 8, the trigger retainer 22' shown in Figure 5 of the Richards reference was interpreted as both the claimed forward grip member recited in original claim 3, and the ring mounted on the rod recited in original dependent claim 8. Because it is necessary to interpret the trigger retainer 22' in Figure 5 of the Richards reference as two separate component parts of the invention recited in amended claim 8, i.e. the forward grip member and the ring, the Richards reference fails to identically show every element of the claimed invention recited in new independent claim 8, and therefore fails to anticipate that claim. Claim 8 and its dependent claims 9-11 are therefore allowable over the prior art.

**Allowable Subject Matter**

It is noted that claim 2 has been allowed.

It is also noted that claims 10, 11, and 14 have been objected to for depending from rejected base claims, but were indicated as being allowable if rewritten in independent form including all of the limitations of their base claims and any intervening claims.

It is respectfully submitted that in view of the amendments and remarks presented herein, the application is in condition for allowance and a favorable action is requested.

Respectfully submitted,  
**Thompson Coburn LLP**

By: Joseph M. Rolnicki  
Joseph M. Rolnicki  
Reg. No. 32,653  
One US Bank Plaza  
St. Louis, MO 63101-1693  
(314) 552-6286